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A.T.R.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/228,325 01/11/99 STEVENS

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021552 QM12/1206

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CHAMBERS, M

ART UNIT

PAPER NUMBER

3711

#77

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/228,325

Applicant(s)

Stevens

Examiner

M. Chambers

Group Art Unit

3711



☒ Responsive to communication(s) filed on Nov 17, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

This Office Action is a response to the Application filed on:

Number	Name	Date	Claims	Independent Claims
09/228325	Stevens	1/11/99	18	2

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being **anticipated** by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Nunes**. Nunes discloses a frame (69), an acrylic backboard (6:15-22) and an elastomeric adhesive (6:46-50). It would have been obvious to one of ordinary skill in the art to have employed various adhesive methods to attach the backboard to the frame based on design and economic choices.

Alternatively

Claim 1 is rejected under 35 U.S.C. 102(b) as being **anticipated** by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Hying et al**. Hying et al discloses a frame (1), an acrylic backboard (3) and an elastomeric adhesive (5, 2:27-28). The claim language if read broadly would be anticipated by **Hying et al**. If the applicant believes the adhesive disclosed is not an elastomeric adhesive, the use of various adhesives is well known in the art. It would have been obvious to one of ordinary skill in the art to have employed various adhesive methods to attach the backboard to the frame based on design and economic choices.

3. Claims 2-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hying et al** as

applied to claim 1 above, and further in view of **Machida, Nunes and 3M-data. Hying et al** discloses the elements in claim 1. However **Hying et al** fails to disclose a plurality of equivalent attachment means. **Machida** discloses a plurality of equivalent attachment means (3:44-45). It would have been obvious to one of ordinary skill in the art to have employed the adhesive means of **Machida** with the apparatus of **Hying et al** depending on design choices and production costs. As to claims 3,4,5,6,15: No criticality is given to the type of adhesive used. It would have been obvious to one skilled in the art to be aware of the adhesives available in the art and would have chosen an appropriate adhesive and followed appropriate set time instructions provided by the adhesive manufacturer.

As to claims 7-10, 16-18 : No criticality is given to the step of providing bond gap spacers in an adhesive. Including glass micro spheres is well known in the art (3M data sheet- pg 2). It would have been obvious to one of ordinary skill in the art to have included micro spheres in the adhesive in order to reduce the amount of adhesive used and insure the adhesive bonded uniformly.

As to claims 11, 12 :**Hying et al** discloses a metal frame (1). It would have been obvious to one of ordinary skill to have employed painted metal in order to avoid the metal rusting.

As to claims 13: **Nunes** discloses the placing of indicia on an acrylic surface (fig 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included indicia on the backboard to more easily permit the placing of the adhesive and frame during assembly. It is also well known to place position marks on articles to insure they are properly placed when bonded together.

As to claim 14: See base claim rejection.

As to claim 15 : No criticality is given to the step of providing bond gap spacers in an adhesive. Including glass micro spheres is well known in the art (3M data sheet- pg 2). It would have been obvious to one of ordinary skill in the art to have included micro spheres in the adhesive in order to reduce the amount of adhesive used and insure the adhesive bonded uniformly.

Concerning the following items:

- a) The particular type of adhesive used.
- b) The amount of and method in which the adhesive is applied.
- c) The type or structure of the bond gap spacers used in applying the adhesive.
- d) The preparing of surfaces prior to applying adhesive.
- e) The printing of position marks on the articles for applying adhesive. .

No criticality or relevancy can be shown for the above items. If the applicant believes any of these items have a criticality or relevancy, then they should discuss the features which are novel or an improvement over prior art which they believe are patentable and non-obvious to one of ordinary skill in the art, when they response to this office action. The overall functionality of the apparatus described in the specification is maintained regardless of any change in these items. Furthermore one of ordinary skill in the art would have appreciated the various types of material/indicia and dimensions which could be used and would have chosen those items or the combinations of those items which would best provide/enhance the apparatus.

Conclusion

Response to Arguments

4. Applicant's arguments filed 11/27/00 have been fully considered but they are moot in light of the new rejection.

First, the applicant's invention differs in structure from that taught in the Nunes patent, and is thus not anticipated by it. In distinguishing a section 102 rejection from a section 103 rejection, the MPEP notes that "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." According to claim 1 of the instant application, the applicant's invention is comprised of at least the following elements: "a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and an elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface." The Nunes patent does not teach an acrylic backboard, a backboard frame structure, a bonding surface on the frame, a bonding surface on the backboard, or the use of an elastomeric adhesive between the frame and the acrylic backboard, and thus Nunes does not anticipate the applicant's invention.

The following definitions are from The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company.

acrylic resin *noun*

Any of numerous thermoplastic or thermosetting polymers or copolymers of acrylic acid, methacrylic acid, esters of these acids, or acrylonitrile, used to produce paints, synthetic rubbers, and lightweight plastics.

back-board (bàk'bôrd', -bôrd') *noun*

1. a. A board placed under or behind something to provide firmness or support. b. A board placed beneath the body of a person with an injury to the neck or back, used especially in transporting the person in such a way as to avoid further injury.
2. *Basketball.* The elevated vertical board from which the basket projects.

e-las-to-mer (i-làs'tə-mər) *noun*

Any of various polymers having the elastic properties of natural rubber.

The examiner notes that the applicant has provided a very rudimentary specification which would indicate that there was an assumption that there was an assumption by the applicant that one of ordinary skill in the art was well versed in adhesives and their use. But in the response to the office action, there is a belief that one of ordinary skill would not be familiar with basic bonding adhesives currently used or available for use. If the examiner were to follow the applicant's belief of what one skilled in the art would be aware of, the specification would be objected to. The applicant has claimed an acrylic backboard, frame and adhesive bonding agent. Claim 1 requires a backboard, bonding surface and adhesive. The reference cited (6:20-22) notes fasteners molded therewith if of plastic or the like. The examiner can see no reason why

acrylic would not be considered plastic based on the definition above. The examiner notes that the device of Nunes has a backboard as defined above (229), a magnet which would act as a frame (69) which can be attached to the backboard adhesively (6:38-39).

The elastomeric adhesive of the applicant's invention is similarly not taught by Nunes. This element is important to the applicant's invention since the bond between the backboard and the frame should be both flexible and durable. (Specification, page 1, beginning at line 21.) Nunes teaches away from the use of elastomeric adhesives, listing first a magnet as the "mounting means," then listing a "permanent adhesive" only as part of a list of such means including suction cups, repositional adhesive, hooks, or hook receiving holes, none of which can be considered an "elastomeric" adhesive. These listed mounting means do not have the durable and flexible characteristics of the elastomeric adhesives taught in the instant application.

If the applicant is arguing that the adhesive used in the instant invention is not a permanent adhesive, then they should note that in their claim language. The examiner further notes that the use of adhesive material to bond an acrylic backboard to a frame is considered old art (Hying et al, 2:26-28). It is not novel to use various types of adhesives to bond the backboard to the frame. One of ordinary skill would have chosen an appropriate adhesive based on manufacturing specifications. If the applicant believes there are unexpected results from this old art, they should expound on these when replying to this action.

Conclusion

The prior art made of record and relied upon.

Patent Number	Date	Patent Name	Notes
5677896	10/14/97	Nunes	
5839982	11/24/98	Hying et al	
NPL	12/98	3M Data Sheet	
4951179	8/21/90	Machida	

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Chambers** whose telephone number is (703) 306-5516. The examiner can normally be reached on Mon.-Fri. from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette E. Chapman, can be reached on (703) 308-1310. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be

directed to the receptionist whose telephone number is (703) 308-1078.

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC3700 is encouraging FAXing of responses to Office Actions directly into the group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner, art unit and case number at the top of your cover sheet. Papers submitted via FAX into TC3700 will be promptly forwarded to the examiner.


JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700